

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LORI ANN WILSON,
JOHN W. COLYN,
GRACE LAI and
GRAIG MORRIS

Appeal 2007-0004
Application 09/751,397
Technology Center 1700

Decided: March 30, 2007

Before THOMAS A. WALTZ, CATHERINE Q. TIMM, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

Statement of the Case

This is an appeal under 35 U.S.C. § 134 from a final rejection of claims 1-3, 6, 8-12, 34, and 35. We have jurisdiction under 35 U.S.C. § 6.

We AFFIRM.

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Appellants invented a cooked buoyant whole-grain waxy wheat food product. The cooked waxy wheat food product is storage stable for prolonged periods of time without becoming rancid, even without the addition of preservatives that inhibit the development of rancidity (Specification 1). Independent claim 1 is reproduced below:

1. Cooked, buoyant whole grain waxy wheat comprising no more than about 10% amylose starch, and less than 20% by weight protein characterized by being gelatinized throughout and storage stable in the absence of additives that inhibit development of rancidity for at least 6 months.

The prior art set forth below is relied upon by the Examiner as evidence of obviousness:

Alderman US 2,526,792 Oct. 24, 1950

Am. Assoc of Cereal Chemists, Wheat Chemistry and Technology, 10,16-17
(Y. Pomeranz ed. 1988).

Nakamura, *Production of waxy (amylose-free) wheats*, Mol. Gen. Genet. 248:253-59 (1995).

Claims 1-3, 6, 8-12, 34, and 35 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Alderman in view of Nakamura and Pomeranz. Claims 34 and 35 stand rejected under 35 U.S.C. §112, second paragraph, as indefinite.

I. Claims 1-3, 6, 8-12, 34, and 35 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Alderman in view of Nakamura and Pomeranz.

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The Examiner finds that claim 1 distinguishes from the cooked-puffed waxy cereal food product of Alderman in that the reference does not disclose the grain is waxy wheat and coating the grain with an edible coating (Answer 4). The Examiner finds that Nakamura discloses the production of waxy wheat grains. The Examiner also finds that Pomeranz discloses the protein content for soft and hard wheat (Answer 4). The Examiner concludes that it would have been obvious for one with ordinary skill in this art to utilize known waxy grains in the cereal food product of Alderman (Answer 4).

The Appellants argue that the Examiner's conclusion of obviousness is incorrect as the product disclosed in Alderman is not waxy wheat that is not storage stable for greater than six months in the absence of additives that inhibit rancidity (Br. 9). Appellants further argue that the Examiner must point to some teaching, suggestion, or motivation found within the references themselves that would lead a person of ordinary skill in the art to combine the references (Br. 8).

Issue

Would one with ordinary skill in this art have reasonably expected success in combining the teachings of Alderman, Nakamura, and Pomeranz in the manner proposed by the Examiner?

Findings of Fact

Appellants invented a cooked buoyant whole-grain waxy wheat food product comprising no more than about 10% amylose starch and less than 20% by weight protein (Specification 8-9).

The Specification discloses that waxy wheat products having less than about 10% amylose are known by persons of ordinary skill in this art (Specification 10).

The Specification discloses that the food product of the invention is characterized by being storage stable in the absence of additives, such as tocopherols and BHT, that preferably inhibit development of rancidity for at least 6 months (Specification 10).

The Specification discloses that rancidity may be determined by taste, odor, or by using standard means such as gas chromatography to determine the amount of hexanal produced (Specification 11).

Alderman describes cooked-puffed waxy cereal food products (Col. 2, ll. 8-13). The food product comprises the waxy variety of cereal grains (Col. 2, ll. 23-27). Alderman discloses a process for producing the cereal food product where the whole-grain component is ground into flour and made into dough (Col. 3, ll. 2-3). Alderman discloses the process for producing the food product comprising coating and then puffing which are carried out by practices known in the art (Col. 3, ll. 23-38). The resulting food product after cooking has a moisture content for the grain elements in the range of 30-40% (Col. 3, ll. 54-58). However, waxy wheat is not described as the grain utilized in producing the food product of Alderman.

Nakamura describes the production of waxy amylose-free wheat (Page 253, left column). Nakamura discloses amylose-free waxy wheat is suitable for the production of flour (Page 258, left column).

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Pomeranz discloses the protein content of wheat can vary from 9-15% depending upon the grain hardness (Page 10). Pomeranz also discloses the species *triticum aestivum* can have grain hardness ranging from soft to hard (Page 16). *Triticum aestivum* is disclosed to be suitable for the production of flour (Page 17).

Principles of Law

Obviousness under 35 U.S.C. § 103 does not require absolute predictability of success. *In re O'Farrell*, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988). For obviousness under § 103, all that is required is a reasonable expectation of success. *Id.*

“Once a prima facie case of obviousness has been established, the burden shifts to the applicant to come forward with evidence of nonobviousness to overcome the prima facie case.” *In re Huang*, 100 F.3d 135, 139, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996).

The question as to whether unexpected advantages have been demonstrated for the claimed subject matter is a factual question. *See In re Johnson*, 747 F.2d 1456, 1460, 223 USPQ 1260, 1263 (Fed. Cir. 1984).

The Appellants must supply a factual basis to rebut the prima facie case of obviousness established by the Examiner. *See, e.g., In re Klosak*, 455 F.2d 1077, 1080, 173 USPQ 14, 16 (CCPA 1972).

Analysis¹

The Examiner has found that a person of ordinary skill in the art would have reasonably expected that known waxy wheat grain could have been used in the process of Alderman to produce a cooked-puffed waxy cereal food product. (*See Answer 4-5*). It is not disputed that the waxy wheat grain products are known to persons of ordinary skill in the art. It is not undisputed that Alderman describes cooked puffed waxy grain containing cereal food products. A person of ordinary skill in this art would have reasonably expected that wheat grain could have been used in place of the whole grain products described in Alderman to produce a cooked puffed waxy wheat grain cereal food product because it is recognized that wheat grain is suitable for the production of flour. For obviousness under § 103, all that is required is a reasonable expectation of success. Obviousness does not require absolute predictability of success.

The Appellants argue that the product disclosed in Alderman is not waxy wheat and the process of Alderman does not produce a waxy wheat that is storage stable for greater than six months in the absence of additives that inhibit rancidity as specified in claim 1 (Br. 9). Appellants rely on a Declaration filed under 37 C.F.R. § 1.132 by Wilson in support of this

¹ Appellants have not presented separate arguments for the rejected claims. Thus, we will limit our consideration to claim 1. We note Appellants have presented a separate heading for the rejection of claims 34 and 35. (*See Brief page 15*). However, Appellants have failed to provide substantive arguments in this portion of the Brief that are different than those previously presented in the Brief.

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argument.² Appellants contend that the Declaration establishes that the utilization of wheat grain in the process of Alderman does not produce a cooked buoyant whole-grain waxy wheat that is storage stable for greater than six months in the absence of additives that inhibit rancidity (Br. 9).

We do not find Appellants' evidence sufficient to outweigh the evidence of obviousness relied upon by the Examiner. In this regard, we note that a review of the Declaration evidence reveals a variety of differences between the reproduced Example 5 of Alderman in the Declaration and that described in the Alderman reference. For example, the Alderman reference discloses that the cooked material was dried to 18-20% moisture and tempered for 20 hours. However, the Declaration states the cooked material was dried to a moisture of 16.1% and tempered for 24 hours. The Declaration also does not indicate the conditions that were utilized when transferring the cooked material through the flaking rollers.

We note that the Declaration purports to provide storage stability results for the reproduced product of Alderman and a sample representative of the claimed invention. (*See* paragraph 10). The data presented in Table 1 exhibits storage stability for six months. We note that after four months of storage the conditions of the storage were modified and "accelerated." The present record is unclear as to what were the effects of the acceleration on the data presented for 4 months and 2 weeks and the data presented for 6 months (4 months and 8 weeks). Furthermore, Appellants have not

² The Declaration was signed on March 23, 2005. A copy of this Declaration has been attached to Appellants' Brief.

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indicated that the acceleration technique utilized in the Declaration is included in what is meant by storage stable for six months as specified in the claimed invention.

The question as to whether unexpected advantages have been demonstrated for the claimed subject matter is a factual question. *See In re Johnson*, 747 F.2d 1456, 1460, 223 USPQ 1260, 1263 (Fed. Cir. 1984). Thus, it is incumbent upon the Appellants to supply the factual basis to rebut the *prima facie* case of obviousness established by the Examiner. *See, e.g., In re Klosak*, 455 F.2d 1077, 1080, 173 USPQ 14, 16 (CCPA 1972). In this regard, Appellants' position that the Declaration establishes that the claimed invention is nonobvious from the teachings of Alderman, Nakamura, and Pomeranz is not persuasively explained or substantiated on this record. Appellants have not adequately explained why the differences in the reproduction of the Alderman example produces a product that is representative of the Alderman invention. Furthermore, the declarant has not indicated that the results achieved by the presently claimed invention are in fact unexpected.

We are convinced by these circumstances that a reasonable expectation of success exists for the Examiner's proposed combination of the Alderman, Nakamura, and Pomeranz. Therefore, the record before us, on balance, establishes an unpersuasively-rebutted *prima facie* case of obviousness with respect to the Examiner's rejection.

Conclusion of Law

Based on the record of this appeal, one with ordinary skill in this art would have had a reasonable expectation that waxy wheat grain could have been used in place of whole grains in the process of producing cooked puffed waxy cereal food products of Alderman in the manner proposed by the Examiner.

II. Claims 34 and 35 stand rejected under 35 U.S.C. §112, second paragraph, as indefinite.

The issue presented is: Whether the Examiner has established that the subject matter of claims 34 and 35 meets the requirements of 35 U.S.C. §112, second paragraph? We answer this question in the negative.

“The legal standard for definiteness [under the second paragraph of 35 U.S.C. §112] is whether a claim reasonably apprises those of skill in the art of its scope” *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). The inquiry is to determine whether the claim sets out and circumscribes a particular area with a reasonable degree of precision and particularity. The definiteness of the language employed in a claim must be analyzed not in a vacuum, but in light of the teachings of the particular application. *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

The Examiner contends that the subject matter of claims 34 and 35 is indefinite because they depend upon claims that have been withdrawn from consideration (Answer 5). We do not agree with the Examiner's assertion that the claims are “vague and indefinite” simply because they are dependent

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on withdrawn claims (Answer 5). The status of the claims from which claims 34 and 35 depend is not material to the question of definiteness. The subject matter of claims 34 and 35 is directed to cooked, buoyant whole-grain waxy wheat that have been produced by the specified process conditions identified in claims 13 and 32 respectively. Thus, we determine that the claims reasonably apprise those of ordinary skill in the art of their scope.

Decision

The decision of the Examiner rejecting claims 1-3, 6, 8-12, 34, and 35 under 35 U.S.C. § 103(a) as unpatentable over Alderman in view of Nakamura and Pomeranz is affirmed. The decision of the Examiner rejecting claims 34 and 35 under 35 U.S.C. §112, second paragraph, as indefinite is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED

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